

REMARKS

Applicant respectfully requests reconsideration of this application as amended. Claims 1-25 were pending in the application. Claims 1, 14, and 24 have been amended. Claims 7 and 17 have been canceled without prejudice.

The Examiner rejected claims 1-6, 10-16, and 20-25 under 35 U.S.C. §103(a) as being unpatentable over Magnus et al. (WO 02/082359; hereinafter “Magnus”) as modified by Zdybel, Jr. et al. (U.S. Patent No. 5,486,686; hereinafter “Zdybel”). Applicant respectfully traverses the rejection.

Claim 1 as amended sets forth “the identification information comprising an **identification (ID) icon**” (claim 1, emphasis added). The Examiner admitted in the Office Action that neither Magnus nor Zdybel discloses the above limitation (Office Action, p. 4, second paragraph). However, the Examiner cited Patton et al. (U.S. Patent No. 5,757,468; hereinafter “Patton”) to argue that Patton made up the deficiencies of Magnus and Zdybel. Applicant respectfully disagrees with the Examiner and submits that Patton merely discloses a **sound** icon 12 on a photographic print (Patton, Figures 1, 7, and 11; col. 1, lines 49-51; col. 5, lines 1-55; col. 8, line 8). According to Patton, the sound icon 12 indicates whether sound exists for the associated print image at the time of print development (Patton, col. 5, lines 46-50) or to represent a cartridge identification number that identifies the filmstrip of the print image (Patton, col. 5, lines 9-20). Patton does not disclose identification information comprising an identification icon to associate the hardcopy representation of an electronic application with the electronic application. Therefore, Patton fails to make up the deficiencies in Magnus and Zdybel. For at least this reason, claim 1 as amended is patentable over Magnus in view of Zdybel and Patton. Withdrawal of the rejection is respectfully requested.

In addition to, or as an alternative to, the above reason, claim 1 as amended is patentable over Magnus in view of Zdybel and Patton for the following reason.

Magnus, Zdybel, and Patton do not provide any motivation to one of ordinary skill in the art to combine their disclosures. The Examiner argued that it would have been obvious to one of ordinary skill in the art to combine the disclosures of Magnus, Zdybel, and Patton in order to provide a visual acknowledgement of the information (i.e., ID) printed with an icon to the operator to further offer an aesthetic appeal to the hard copy" (Office Action, p.4, fourth paragraph). Applicant respectfully submits that none of Magnus, Zdybel, and Patton discloses or suggests any concern or any desire to use an icon to provide aesthetic appeal to a hardcopy. Specifically, the use of the sound icon 12 in Patton is not for aesthetic reason, but for a practical reason, i.e., to indicate whether sound exists for the print image (Patton, col. 5, lines 46-50). As warned by the Federal Circuit, it is impermissible to pick and choose among isolated disclosures in the prior art, through hindsight reconstruction, to show obviousness of the claimed invention. In re Fritch, 972 F.2d 1260, 1266 (1992). Since Magnus, Zdybel, and Patton do not provide any motivation to one of ordinary skill in the art to combine their disclosures, claim 1 as amended is patentable over Magnus in view of Zdybel and Patton. Withdrawal of the rejection is respectfully requested.

Claims 2-6 and 8-13 depend, directly or indirectly, from claim 1. For at least the reasons discussed above with respect to claim 1, claims 2-13 are patentable over Magnus in view of Zdybel and Patton. Applicant respectfully requests the Examiner to withdraw the rejections.

Applicant respectfully submits that claims 14 and 24 as amended are patentable over Magnus in view of Zdybel and Patton for at least the reasons discussed above with respect to claim 1. The Examiner is respectfully requested to withdraw the rejections.

Claims 15-16, 18-23, and 25 depend, directly or indirectly, from claims 14 and 24 respectively. Therefore, claims 15-23, and 25 are patentable over Magnus in view of

Zdybel and Patton for at least the reasons discussed above with respect to claims 14 and 24.

The Examiner rejected claims 8-9, and 18-19 under 35 U.S.C. §103(a) as being unpatentable over Magnus, as modified by Zdybel as applied to claim 1, and further in view of Patton. For the reasons discussed above with respect to claim 1, Applicant respectfully traverses the rejection. Withdrawal of the rejection is respectfully requested.

Accordingly, Applicant respectfully submits that the rejections under 35 U.S.C. §103(a) have been overcome by the remarks and withdrawal of these rejections is respectfully requested. Applicant submits that claims 1-6, 8-16, and 18-25 as amended are now in condition for allowance and such action is earnestly solicited.

Please charge any shortages and credit any overcharges to our Deposit Account No. 02-2666.

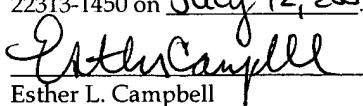
Respectfully submitted,
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Esther L. Campbell 7-12-04
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